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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY L. OEHRKE

Appeal 2009-006432
Application 09/594,070
Technology Center 2400

Decided: March 30, 2010

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT,
and JAY P. LUCAS, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 3-5, 7-9, 11-13, and 15-19, which are all of the claims pending in this application as claims 2, 6, 10, and 14 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellant's invention relates to messaging in computer networks for guaranteed messaging service on an internet provider (IP) network (Specification 1). According to Appellant, instead of returning a message as undeliverable, the message is rerouted to a relay server (Specification 2) which attempts to re-send or re-route the message (*id.*).

Independent Claim 1 reads as follows:

1. A method for providing a messaging service on a computer network, the method comprising the steps of:

- (a) routing a message to a messaging server;
- (b) providing the message to a relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server;
- (c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational; and
- (d) invoking another messaging server if the messaging server in step (c) does not become operational.

The prior art references relied upon by the Examiner in rejecting the claims on appeal are:

Nelson	US 5,974,122	Oct. 26, 1999
Mead	US 2001/0036822 A1	Nov. 1, 2001
	(effectively filed Apr. 10, 2001)	
Ozzie	US 6,859,821 B1	Feb. 22, 2005
		(filed Jul. 19, 1999)

Whatis.com, DNS (domain name system),
<http://web.archive.org/web/20000307002913/whatis.com/dns.htm> (last visited Aug. 17, 2007) (hereinafter DNS).

Claims 1, 3-5, 7, and 8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Nelson.

Claims 1, 3-5, 7-9, 11-13, 15, and 16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ozzie.

Claims 1, 3-5, 7-9, 11-13, and 15-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Mead.

Claims 9-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson and DNS.

Claims 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ozzie.¹

We make reference to the Briefs and the Answer for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

1. Under 35 U.S.C § 102(e), with respect to appealed claims 1, 3-5, 7, and 8, does Nelson anticipate the claimed subject matter by teaching all of the claimed limitations?
2. Under 35 U.S.C § 102(e), with respect to appealed claims 1, 3-5, 7-9, 11-13, 15, and 16, does Ozzie anticipate the claimed subject matter by teaching all of the claimed limitations?

¹ The rejection of claim 18 under 35 U.S.C § 112, second paragraph is withdrawn, as indicated by the Examiner in page 31 of the Examiner's Answer.

3. Under 35 U.S.C § 102(e), with respect to appealed claims 1, 3-5, 7-9, 11-13, and 15-19, does Mead anticipate the claimed subject matter by teaching all of the claimed limitations?

FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issues involved in the appeal.

Appellant's Specification

1. Appellant's Specification describes the claim term "invoking another messaging server" as designating another server as the destination by the relay server 18, as stated below:

If attempts by relay server 16 to deliver a message to destination messaging server 14 are unsuccessful, relay server 16 invokes a process that invokes messaging server 18. In this embodiment, messaging server 18 comprises a redundant standby messaging server or redundant operating messaging server. *By invoking messaging server 18, relay server 16 designates messaging server 18 as the destination* of messages for particular addresses or domain names, such as addresses originally intended for messaging Server 14. In other embodiments, relay server 16 notifies a different server of the unavailability of messaging server 14. *This other server then invokes messaging server 18 to act as the destination* for messages.

(Emphasis added.)

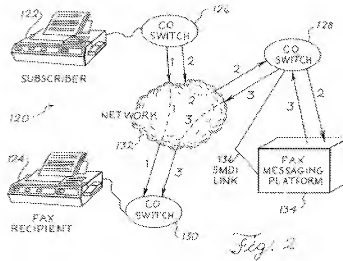
(Spec. 5:25-6:3.)

Nelson

2. As shown in Figure 2, Nelson discloses the operation of a telecommunication system where a subscriber 122 attempts to send a facsimile message to fax recipient 124. If the recipient 124 is busy or does

not answer, the message is routed to messaging platform 134 for storage and redelivery. The messaging platform 134 attempts to call the fax recipient or continue trying if the message cannot be delivered on the first attempt. (Col. 3, l. 64 – col. 4, l. 14.)

3. Figure 2 of Nelson is shown below:



Nelson shows in Figure 2 the fax messaging platform 134 where the undelivered messages are stored for redelivery.

Ozzie

4. As depicted in Figure 8, Ozzie discloses a messaging system for communication between a number of peer units 802A-802D where each unit includes a dynamic manager 804A-804D and a communications manager 806A-806D for coordinating and controlling the communication between the peer units. (Col. 15, l. 64 – col. 16, l. 10.)

5. A device presence server 812 ascertains whether the intended destination is on-line, or temporarily disconnected (“off-line”). If the destination is off-line, the communications can be made via a relay 814,

which then forwards the message on to its destination when the destination returns online. (Col. 16, ll. 29-34.)

6. If peer unit 802A seeks to send a message to peer unit 802C, and the presence server 812 has informed the communications manager 806A that the peer unit 802C is on-line, then the communications manager 806A sends the message directly to the URL of the peer unit 802C. (Col. 16, ll. 35-42.)

7. On the other hand, if the peer unit 802A seeks to send a message to the peer unit 802C, and the device presence server 812 has informed the communications manager 806A that the peer unit 802C is off-line, then the communications manager 806A sends the message to the URL of the relay 814. (Col. 16, ll. 43-54.)

Mead

8. Mead relates to methods and systems for delivering electronic mail between users in a vehicle and others outside of the vehicle. (§ [0002].)

9. As shown in Figure 1, Mead discloses a ground server 106, which receives e-mails from the home mail server 102 and is in communication with the vehicle server 110. However, the vehicle server 110 may not necessarily remain in constant communication with the ground server 106 and instead, establishes an intermittent link. (§ [0015].)

PRINCIPLES OF LAW

The scope of the claims in patent applications is determined not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the Specification as it would be

interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

A rejection for anticipation requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. *See Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

ANALYSIS

35 U.S.C § 102(e) Rejection over Nelson

In rejecting claims 1, 3-5, 7, and 8, the Examiner interprets the claim term “invoking” as “using” and states that the FAX messaging platform 134 of Nelson is invoked in order to allow delivery of the message (Ans. 24). The Examiner further argues that the claims merely require invoking another messaging server, rather than requiring the relay message actually be routed to the invoked messaging server (*id.*).

Appellant argues that the FAX messaging platform 134 in Nelson cannot serve as both the “relay server” and the “another messaging server” of claim 1 and deliver a message to itself as “the other messaging server” (App. Br. 8-9). Appellant further points out that the claim term “invoking” is described in the Specification as designating the invoked server as the destination for the message (Reply Br. 3).

We disagree with the Examiner’s position. First, by invoking a server, when interpreted in light of the Specification, the server is designated as the destination of the message (FF 1). Second, while delivering the

message to the invoked server is not required, the claims recite invoking another server which is designated as the destination for the message to be delivered by the relay server (*see* claim 1). Therefore, the FAX messaging platform 134 of Nelson cannot be both the relay server and another messaging server designated to receive the message provided to the relay server. In fact, undeliverable messages are routed to the FAX messaging platform 134 when the fax recipient is unavailable (FF 2). Nelson does not disclose another messaging server to be designated as the destination for the undelivered message when the FAX recipient 124 is busy or does not answer (FF 2-3). Therefore, the 35 U.S.C § 102(e) rejection of claims 1, 3-5, 7, and 8 over Nelson is not sustained.

35 U.S.C § 102(e) Rejection over Ozzie

With respect to the rejection of claims 1, 3-5, 7-9, 11-13, 15, and 16 as anticipated by Ozzie, the Examiner characterizes the relay 814 of Ozzie as both the relay server and the claimed “another messaging server” (Ans. 6; 26). The Examiner reasons that no specific requirement for the term “invoking” is presented in the instant Specification (*id.*). Appellant provides similar arguments discussed above with respect to Nelson and states that the relay 814 in Ozzie stores the undelivered message until the destination peer unit returns on-line (App. Br. 12; Reply Br. 6-7).

We again agree with Appellant and find that based on the above-discussed meaning of the claim term “invoking another messaging server,” Ozzie provides no teaching regarding another messaging server that is designated as the destination for the message. Ozzie merely stores the message in the relay 814 after the device presence server 812 determines that the intended destination peer unit is off-line (FF 4; 7). However, the

relay server 814, instead of invoking another server, sends the message to the destination after the device presence server 812 informs that the destination peer unit is on-line (FF 5-6). Therefore, we cannot sustain the 35 U.S.C § 102(e) rejection of claims 1, 3-5, 7-9, 11-13, 15, and 16 over Ozzie.

35 U.S.C § 102(e) Rejection over Mead

With respect to the rejection of claims 1, 3-5, 7-9, 11-13, and 15-19 as anticipated by Mead, we also find Appellant's arguments (App. Br. 14-16; Reply Br. 7-9) to be persuasive. The disclosure of Mead merely provides for transmission of e-mail messages from the home server 102 to the ground server 106, which is in communication with the vehicle server 110 via an intermittent link (FF 8-9). The portions of Mead relied on by the Examiner provide no disclosure of invoking another messaging server when the messaging server does not become operational, as recited in claims 1 and 9.

We also disagree with the Examiner's characterization of the method steps recited in claim 1 as a Markush group (Ans. 29). As stated by Appellant (Reply Br. 8), each of the recited method steps must be disclosed in the reference in order to be anticipated by that reference. Thus, Mead does not anticipate the claims and the 35 U.S.C § 102(e) rejection of claims 1, 3-5, 7-9, 11-13, and 15-19 over Mead cannot be sustained.

CONCLUSION

On the record before us and in view of the analysis above, we find that the Examiner erred in finding that Nelson, Ozzie or Mead anticipates the appealed claims. Additionally, we do not sustain any of the 35 U.S.C. § 103 rejections of claims 9-19 or 17-19 since the Examiner has not identified any

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modifications to Nelson or Ozzie to overcome the deficiencies discussed above.

ORDER

The decision of the Examiner rejecting claims 1, 3-5, 7-9, 11-13, and 15-19 is reversed.

REVERSED

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